

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,333	01/20/2004	Rick F. Gladney	SMCY-P04-062	9792

7590 09/12/2005

ROPES & GRAY LLP
EDWARD J. KELLY
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

TRETTEL, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3673

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,333

Applicant(s)

GLADNEY ET AL.

Examiner

Michael Trettel

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/11/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Terminal Disclaimer

The terminal disclaimer filed on August 11, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,519,798 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

Claims 1, 2, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosch. Bosch shows a mattress and mattress foundation combination 10 that comprises a mattress 12 of a three layer foam construction that overlies a foundation 20 formed as a wooden boxspring assembly covered by a foam layer 24. The mattress and mattress foundation are of the same width and length. The applicant has claimed a particular set of dimensions for the mattress and foundation set that do not coincide with the well known dimensions commonly used in the industry to make a mattress set. The examiner takes notice that it is well known in the art to make custom sized mattresses to order using any desired set of dimensions. Because of this the actual width of the mattress and/or the boxspring is little more than a matter of design choice that is readily apparent to the skilled artisan. This is because the skilled artisan would design the mattress and boxspring to fit any size needed to fit the intended use of the device, such as use in

Art Unit: 3673

a small room, a large room, in a vehicle, etc. It should be further noted that the applicant has not established the criticality of the particular dimensions claimed, and in fact admits that they are interspersed within a range of dimensions commonly used in the prior art. Essentially, the applicant is attempting to claim a custom size for a commonly known article without showing how this size is beyond the ordinary level of skill in the art.

Claims 1 to 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedlander. Freedlander shows a mattress support that comprises a boxspring 11 that supports a foam mattress 12. A bedboard 13 is placed between the mattress and boxspring to stiffen the overall support offered by the mattress. The bedboard 13 is made from a rubber/fiber composition and can be formed from hinged sections as shown in Figures 5 and 6. Note in particular that in Figure 6 a longitudinal hinge line 33 is formed in the board. As has been set forth above the dimensions claimed and used to make the mattress/boxspring combination are well within the level of skill of the art and would have been obvious to the skilled artisan.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirschman. Hirschman shows a mattress and boxspring assembly in which the mattress is wider than the boxspring. The boxspring includes a pair of side rails 6 that are attached to one another by laterally extending slats 7. Springs 8 are supported upon the slats 7, with shorter springs 10 being supported upon the rails 5. The springs 8, 10 are terminated in a common upper plane and support a spring mattress formed by springs 20. The actual width of the mattress and/or the boxspring is little more than a matter of design choice that is readily apparent to the skilled

Art Unit: 3673

artisan. This is because the skilled artisan would design the mattress and boxspring to fit any size needed to fit the intended use of the device, such as use in a small room, a large room, in a vehicle, etc. It should be further noted that the applicant has not established the criticality of the particular dimensions claimed, and in fact admits that they are interspersed within a range of dimensions commonly used in the prior art. Essentially, the applicant is attempting to claim a custom size for a commonly known article without showing how this size is beyond the ordinary level of skill in the art.

Claims 5, 6, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan. Morgan shows a boxspring/mattress combination that is of particular interest. The boxspring comprises a rectangular frame 12 that has an extension attached to its upper periphery. The upper surface of the boxspring 12 is formed with a peripheral frame formed by edge members 16 which are spanned by lateral slats 30, however the examiner takes notice that is well known in the art to make the upper surface of a boxspring from a solid sheet of material such as plywood or masonite. The extension is formed by a rectangular frame member 34 that forms a lip about the edge of the foundation or boxspring. As is disclosed in column 3, lines 45 to 55 the width of the lip can range from .375 inches to 5 inches. A spring mattress is fitted to the top of the boxspring, as is shown in Figure 2 the edges of the mattress are contiguous with the edges of the lip attached to the boxspring. As stated earlier the actual width of the mattress and/or the boxspring are little more than a matter of design choice that is readily apparent to the skilled artisan. This is because the skilled artisan would design the mattress and boxspring to fit any size needed to fit the intended use of the device, such as use in a small room, a large room, in a

Art Unit: 3673

vehicle, etc. It should be further noted that the applicant has not established the criticality of the particular dimensions claimed, and in fact admits that they are interspersed within a range of dimensions commonly used in the prior art. Essentially, the applicant is attempting to claim a custom size for a commonly known article without showing how this size is beyond the ordinary level of skill in the art.

Claims 6 to 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirschman as applied to claim 5 above, and further in view of Freedlander. Freedlander teaches that it is very well known in the art to place a stiffening member 13 between a boxspring and mattress for the purpose of improving the support offered by the mattress. It would have been obvious to the skilled artisan to have placed a stiffening member between the mattress and boxspring combination shown by Hirschman as is taught by Freedlander, for the purpose of improving the support of the mattress assembly.

Claims 5, 6, 8, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (4,169,294). Harris shows a platform style bedframe 10 that comprises a rectangular frame formed by side members 12 and end members 16. The side and end members are formed with a vertically extending portion and a horizontally extending portion such that a "stepped" frame is formed that is wider on its upper portion than on its bottom. Note that the stepped portion extends outwardly of the frame to a substantial degree. A mattress and boxspring combination can be placed directly upon the platform, or alternately a mattress alone may be placed upon it. Notice that the side edges of the side members are provided with retaining lips

Art Unit: 3673

20 which are used to prevent sideways displacement of the mattress of the platform. As disclosed in column 4, lines 60 to 66 a flat board or a slat/board combination may be placed upon the platform prior to placing a mattress upon it. The comments offered earlier concerning the claimed dimensions of the mattress and/or foundation apply in this particular instance.

Response To Arguments

Applicant's arguments filed on August 11, 2005 have been fully considered but they are not persuasive. The applicant has fundamentally misunderstood the grounds of rejection, and has presented an argument against a rejection that was never made. The examiner has not made a rejection based upon official notice, but has instead based the rejection upon the proposition that the claimed dimensions are within the ordinary level of skill in the art since they are no more than a customized set of dimensions. As noted in the rejection above, the dimensions claimed are within a range of well known dimensions commonly used within the art. This is admitted as much by the applicant on pages 2 and 3 of the specification. Instead of consulting MPEP 2144.03 the applicant should consult MPEP 2144.05 for a background on rejection based upon the use of ranges within claims, since this is more pertinent to the issue at hand. In particular, the applicant appears to have done no more than settle upon an optimized mattress size that lies within a set of well known mattress sizes, i.e., the applicant is claiming one particular size within a range of well known sizes. This size lies between the already known size used for a King sized mattress and a Queen sized mattress, and appears to be no more than optimizing to a selected size based upon routine experimentation. The type of experimentation needed is mentioned in pages 2 and 3 of the applicant's specification, and does not appear to be particularly difficult to

Art Unit: 3673

perform by the skilled artisan. The claims appear to be analogous to the situation covered in MPEP 2144.05, section II, subsection A:

"[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Also see *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.").

Since the rejection is not based upon official notice there is no need for the examiner to show that the particular dimensions claimed are known *per se* within the prior art. As noted repeatedly throughout the rejection above the applicant has been asked to demonstrate the criticality of the dimensions claimed and asserted as being critical feature of the invention. Since no such demonstration has been made the rejection has been repeated and will be made Final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


Art Unit: 3673

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Trettel whose telephone number is (571) 272-7052. The examiner can normally be reached on Monday, Tuesday, Thursday, or Friday from 7.30 am to 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (571) 272-7052. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Michael Trettel
Primary Examiner
Art Unit 3673